

REMARKS

The Applicants respectfully submit this Amendment And Request For Reconsideration contemporaneously with the present Request for Continued Examination (RCE) in response to the Office Action mailed on 09 May 2008, entry of which is earnestly solicited.

In the present Amendment, the Applicants amend claims 1, 2, 4-5, 7-8, 10-11, 13-14, 16, 18, 20, 23, 25, 27-28, 30, 32, and 50, cancels claims 35 and 39, and adds new claims 51-53. The Applicants respectfully submit that no new matter has been presented; the amendments and new claims are supported by the application as originally filed. Thus, claims 1-53 as amended are pending in the application for reconsideration.

In the Office Action mailed on 09 May 2008, the Examiner rejected claims of the present application under 35 U.S.C. § 103(a) based on Otting et al. (U.S. Patent No. 6,567,663), Bridges et al. (U.S. Patent No. 7,096,015), and Johannesson et al. (U.S. Patent Application Publication No. 2002/0119774). In response, the Applicants respectfully disagree with the rejections and submits that the claims as amended are allowable over the prior art of record for at least the following reasons.

In order to properly establish rejections under 35 U.S.C. § 103(a), the prior art in combination must teach or suggest each and every limitation of the claims. There must also be a proper obviousness/non-obviousness assessment that includes some adequate reasoning and/or demonstration that one ordinarily skilled in the art would have combined the teachings of the references to produce that which is claimed. When considering various prior art teachings for an obviousness/non-obviousness determination under §103,

the scope and content of the prior art are to be determined; differences between the prior art and the claims at issue are to be ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or non-obviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented. *Graham vs. John Deere Co. of Kansas City*, 383 U.S. 1, pp 17-18 (1966).

In this analysis, a functional approach may be taken which asks whether the improvement of the presented invention is more than a predictable use of prior art elements according to their established functions. It is also helpful and instructive to consider whether there is any teaching, suggestion, or motivation to combine the teachings of the references, either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art, in a flexible and non-rigid manner. The reason or evidence of a motivation to combine teachings need not be found explicitly in the prior art references, as one may also "look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art." *KSR Int'l Co. v. Teleflex Inc. et al.*, 127 S.Ct. 1727, at 1740-41.

Regarding Claims 1-17, 33-43, and 50-53. With respect to claims 1-17, 33-43, and 50-53, the relied upon art fails to teach, suggest, or render obvious the performance of the actions of "if a home communication network of the mobile station is identified as being available, selecting and operating with the home communication network", "otherwise, if the home communication network is unavailable and the non-home communication network is identified as being available, selecting and operating with the non-home communication network", but then "otherwise, if the non-home communication network is unavailable: selecting and operating with an alternate

communication network in accordance with an automatic or manual network selection method” – steps which are performed “in response to regaining signal coverage from an out-of-coverage condition with the non-home communication network” or “in response to being powered-on from a power-off state entered while operating with the non-home communication network” (see e.g. claim 1) or the like.

In the Office Action, the Examiner admits that Otting et al. do not disclose the performance of actions “in response to regaining signal coverage from an out-of-coverage condition with the non-home communication network, or in response to being powered-on from a power-off state entered while operating with the non-home communication network” as claimed. The Examiner also does not employ the Johannesson et al. reference to identify these limitations. The Examiner instead alleges that Bridges et al. disclose these limitations.

Again, steps in claims 1-17, 33-43, and 50-53 recite in part that “if a home communication network of the mobile station is identified as being available, selecting and operating with the home communication network” and “otherwise, if the home communication network is unavailable and the non-home communication network is identified as being available, selecting and operating with the non-home communication network” (see e.g. claim 1) which are performed “in response to regaining signal coverage from an out-of-coverage condition with the non-home communication network, or in response to being powered-on from a power-off state entered while operating with the non-home communication network” as claimed. As apparent, the Applicants make use of clear antecedent basis to recite a non-home communication network and subsequently the non-home communication network, making clear reference to the previously-registered non-home network.

In the argument, the Examiner makes reference to column 12 at lines 25-36 of Bridges et al. There, Bridges et al. teach the following:

In FIG. 3, a mobile station enters an initialization state at step S.2, when the mobile station is powered ON, changes systems, is in a "No Service" condition, or when an Intelligent Roaming mode (IR mode) has been selected by the user. After the mobile station has been initialized, the mobile station first scans for its home band (i.e., the set of frequencies corresponding to its home network system) at step S.4 to locate a control channel. The set of frequencies corresponding to the home band of the mobile station may be programmed into the mobile station's memory (e.g. memory 67) by the home system service provider.

Note that the Examiner appears to assume that, prior to performing the steps outlined above, the mobile station of Bridges et al. has been previously operating in a non-home communication network. However, there is no explicit teaching of this in Bridges et al. If the Examiner is relying on any inherency argument, the argument fails since the Examiner has failed to explain or articulate any basis for such inherency.

Thus, there is no proper combination of references that results in the combined teaching of "if a home communication network ... is identified as being available: selecting and operating with the home communication network" and subsequently "otherwise, if the home communication network is unavailable ... selecting and operating with the non-home communication network" in response to the stated condition being met.

Even further, the Applicants also distinguish the present techniques from the relied upon art with the additional claimed step of "otherwise, if the non-home communication network is unavailable: selecting and operating with an alternate communication network in accordance with an automatic or manual network selection method" (see e.g. claim 1) or the like.

The Applicants also respectfully submit that there is no adequate reason that one ordinarily skilled in the art would have to combined the teachings of Otting et al. and Bridges et al. in the manner the Examiner suggests in the rejecting of claims 1-17, 33-43, and 50. The teachings of Otting et al. primarily focus on network selection techniques for GSM systems. On the other hand, the teachings of Bridges et al.

primarily focus on the use of SIDs and SOC's in systems such as IS-136 systems. One ordinarily skilled in the art would appreciate that the technologies as presented are not entirely compatible, as different technology standards (i.e. for network selection) exist for these different systems. One ordinarily skilled in the art would appreciate this and take caution in creating new network selection rules.

In conventional GSM techniques, after recovering from an out-of-coverage condition, a mobile station operates to select the PLMN with which it had just previously registered (i.e. its "RPLMN"). If the RPLMN is unavailable, the mobile station performs a scan to identify and select a PLMN which may be the HPLMN. However, the specifications do not clearly and specifically address the situation where the RPLMN is not the HPLMN of the mobile station. If the RPLMN is not the HPLMN, and the HPLMN is available after the recovery from the out-of-coverage condition, it is specified that the mobile station is limited to selecting the non-home RPLMN (if available) upon recovery. Such conventional operation is described in ETSI specs 3.22/23.122.

Advantageously, the present invention provides an inventive solution to such problem. See page 19 at lines 26-31 of the present application:

Thus, the above method provides a solution to a problem that the specifications do not clearly and specifically address: the situation where the RPLMN is not the HPLMN of the mobile station. If the RPLMN is not the HPLMN, and the HPLMN is available after the recovery from the out-of-coverage condition or after power-on, the standards specify that the mobile station is limited to selecting the non-home RPLMN (if available).

Note that independent claim 50 is directed to the particular embodiment as it relates specifically to Global Systems for Mobile Communications (GSM) networks utilizing HPLMNs and RPLMNs.

Note that the Examiner's reasons to combine the reference teachings are confusing at best. For example, and additionally, the Examiner places emphasis on the teaching of an HPLMN timer expiration in the reasons for combining the reference

teachings. However, the claims do not recite any use of an HPLMN timer expiration, and there is no relationship between an HPLMN timer expiration and the condition of "in response to regaining signal coverage from an out-of-coverage condition with the non-home communication network, or in response to being powered-on from a power-off state entered while operating with the non-home communication network." There is no adequate reasoning why one ordinarily skilled in the art would understand that these conditions are similar or the same, especially in the context of GSM communications.

Thus, since there is no adequate reason that one ordinarily skilled in the art would have to combined the teachings of Otting et al. and Bridges et al. in the manner the Examiner suggests, such claims are allowable over the prior art of record. The Applicant respectfully requests the Examiner to withdraw the rejections of claims 1-17, 33-43, and 50-53 and allow such claims.

Regarding Claims 18-32 and 44-49. The prior art of record also fails to teach or suggest the limitations of claims 18-32 and 44-49. The Examiner has also not set forth any proper rejection for the teaching of the limitations of these claims.

In the rejection of claims, the Examiner attempts to describe how the references teach or suggest the limitations of the claims. To illustrate, the Examiner states in part that the references disclose:

...performing the following acts of: if a second communication network of the mobile station is identified as being available selecting and operating with the second communication network otherwise, if the non-home communication network is identified as being available selecting and operating with the first communication network (Col. 7, lines 1-45; Col. 9, lines 27-32; Col. 15, line 64-Col. 16, line 8; and Col. 17, line 66-Col. 18, line 45 of Bridges et al.)

Otting et al. and Bridges et al. do not specifically disclose the act of selecting a public land mobile network to serve a mobile station includes the step of receiving at the mobile station a list of data

associated with networks neighboring the PLMN currently serving the mobile station after an expiration of a predetermined time period...

The Applicant submits that the rejections as provided for these claims (as in the above passage) fail to properly characterize the limitations as claimed and the asserted teachings.

The Examiner has again either misread or misunderstood the limitations in the claims, even having mixed up the "first", "second", "non-home", and "home" networks as claimed. Even if, for example, the term "second" network was replaced with the term "home" network in the Examiner's assertions, this would not properly recite the limitations as claimed. The Examiner has even failed to identify any teaching of "if the non-home communication network is unavailable and the home communication network is also unavailable, causing a list of available communication networks to be displayed for a manual network selection procedure for manual network selection and operating with one of the available communication networks."

Thus, the Examiner's rejections and arguments with respect to claims 18-32 and 44-49 fail. It is difficult if not possible for the Applicant to respond to any rejection if the arguments are not properly characterized or formulated. However, the Applicant respectfully submits that the reason for the difficulty is likely because the prior art of record fails to teach or suggest the limitations of claims 18-32 and 44-49, and there is no adequate reason one ordinarily skilled in the art would have combined the teachings of the references as attempted by the Examiner.

As explained previously, an issue associated with the earlier-described problem of prior art techniques relates specifically to claims 18-32 and 44-49. In particular, GSM standards specify that if the last RPLMN is unavailable while the mobile station is in "manual" network selection mode, the mobile station shall camp on any network providing emergency service. This selected network, however, may not be the optimal

network with which to operate, especially, for example, if the home network is made available.

The present application is directed further to a solution to this additional problem with manual network selection, and is defined in claims 18-32 and dependent claims 44-49. The prior art of record fails to teach or suggest other steps which occur "in response to regaining signal coverage from an out-of-coverage condition with the manually-selected non-home communication network" or "in response to being powered-on from a power-off state entered while in the manual network selection mode." In particular, the prior art fails to teach the following steps which are utilized after such events: "if the non-home communication network is unavailable and the home communication network is also unavailable: displaying a list of available communication networks for a manual network selection procedure for manual network selection and operation with one of the available communication networks" and "if the non-home communication network is unavailable but the home communication network is identified as being available: instead of carrying out the manual network selection procedure for the manual network selection and operation with one of the available communication networks, selecting and operating with the home communication network."

The above-stated and claimed techniques are advantageous, for example, as described on page 22 at lines 1-5:

Advantageously in FIG. 7, even in a manual selection mode where choices are made by the end user, the mobile station makes the end user aware of recent availability of the home network in a timely and unobtrusive fashion. Overall, the mobile station helps facilitate the selection of the best network for the end user even in the manual selection mode.

Based on the above, the rejection of claims 18-32 and 44-49 should also be withdrawn and the claims should be allowed.

Additional reasons for the further allowability of both the independent and dependent claims are apparent to those of ordinary skill in the art, but are not articulated herein due to the reasons already presented above.

As explained above, the prior art in combination fails to teach, suggest, or render obvious claims 1-53, and therefore such claims are allowable over the prior art of record. The Applicant respectfully requests reconsideration of the claims and allowance of the application as all statutory requirements have now been met.

Thank you. Please feel free to contact the undersigned if there are any questions or concerns regarding this submission.

Respectfully submitted,

/John J. Oskorep/

Date: 18 September 2008

JOHN J. OSKOREP
Reg. No. 41,234

JOHN J. OSKOREP, ESQ. LLC
ONE MAGNIFICENT MILE CENTER
980 N. MICHIGAN AVENUE, SUITE 1400
CHICAGO, ILLINOIS 60611 USA

Telephone: (312) 222-1860 Fax: (312) 475-1850